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09/975,417	10/10/2001	Paul Swift	34580.001CC	9594
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			LUONG, VINH	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES** **GROUP 3600**

Paper No. 9

Application Number: 09/975,417

Filing Date: October 10, 2001

Appellant: PAUL SWIFT

Thomas I. Rozsa
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed December 24, 2003.

(1) Real Party in Interest.

The statement of the real party in interest is contained in the brief.

(2) Related Appeals and Interferences.

The statement of the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of claims.

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final.

No amendment after final has been filed. See second paragraph on page 3 of the brief.

The *proposed* amendment after final rejection filed on December 24, 2003 *with the brief* in the Appendix II has not been entered since the new functional statement “the first top rear spring-loaded retaining plate rotates outwardly on a vertical plane” in claims 5-7 raises new issues that would require further consideration and/or search. See MPEP 1207.

(5) Summary of invention.

The summary of invention contained in the brief is correct.

(6) Issues.

The Appellant's statement of the issues in the brief is correct.

(7) Grouping of claims.

Appellant's brief includes a statement that claims 5-8 stand or fall together.

(8) Claims appealed.

The copy of the appealed claims contained in the Appendix I to the brief is correct.

(9) Prior Art of record.

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

6,035,743	GAPINSKI et al. (Gapinski)	Mar. 14, 2000 (Filed: Mar. 18, 1998)
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(10) New prior art.

No new prior art has been applied in this Examiner's answer.

(11) *Grounds of rejection.*

The following grounds of rejection are applicable to the appealed claims:

Claims 5-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Gapinski.

This rejection is set forth in the final rejection on August 5, 2003 (Paper No. 6).

(12) *New ground of rejection.*

This Examiner's Answer does not contain any new ground of rejection.

(13) *Response to argument.*

The Examiner's response to Appellant's arguments in Paper No. 6 is incorporated herein by reference. In the following, the Examiner addresses the Appellant's arguments that have not been treated in Paper No. 6.

I. Whether it is erroneous to cite Gapinski patent filed on March 18, 1998 against the present application?

Appellant contends that "a rear spring-loaded retaining plate" was fully disclosed in the grand parent application Serial No. 08/923,022 (SN'022) filed on September 3, 1997, therefore, Appellant is entitled to the benefit of the September 3, 1997, the filing date of the '022 application. However, it is well settled that in order to gain the benefit of the filing date of an earlier application under 35 USC 120, a later filed application must comply with the written description requirement of 35 USC 112. *In re Huston*, 64 USPQ2d 1801, 1806-07 (Fed. Cir. 2002) citing *Lockwood v. Am. Airlines Inc.*, 107 F.3d 1565, 1571, 41 USPQ2d 1961, 1965-66 (Fed. Cir. 1997).

In the instant case, "a rear spring-loaded retaining plate" was not adequately disclosed in '022 application. In fact, Figs. 5a-5c of SN'022 fail to show the biased spring that makes the

plate 204 to be pivotable. More important, the plate 204 shown in Figs. 5a-5c of SN'022 appears to be fixedly or not pivotably attached to the pedal body 206. Appellant's description of Figs. 5a-5c on page 9 of SN'022 was inadequate because it was unclear as to how Appellant made/use the un-illustrated spring such that the spring biases the plate 204. Note that only claim 4 in SN'022 was examined because claims 1-3 of SN'022 were withdrawn due to the restriction made on February 25, 1999. Since claim 4 of SN'022 did not call for the "rear spring-loaded retaining plate," therefore, the Examiner did not reject claim 4 under 35 USC 112, first paragraph, in the Office action on July 21, 1999.

Appellant abandoned '022 application and filed a Continuation-in-part (CIP) Application No. 09/360,561. The first time Appellant claimed the spring-loaded retaining plate was the time of filing the Amendment on March 5, 2001. Appellant changed Figs. 5a-5c of SN'022 to Figs. 1a-1c and later to Figs. 8a-8c in SN'561. New claims 8-14 filed on March 5, 2001 of SN'561 claim the spring-loaded retaining plate. The Examiner rejected these claims 8-14 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement regarding the spring-loaded retaining plate 204. See the final rejection in Attachment A of the Paper No. 6 of this application.

Appellant did not contest the rejection under 35 USC 112, first paragraph, in SN'561 and chose to file the instant CIP application SN # 09/975,417. In this application SN'417, Appellant adds new matter in new Figs. 18-22. The new matter is the springs 580 and 582 and the pivoted plate 204. Appellant's failure to contest the rejection under 35 USC 112, first paragraph, in SN'561 is considered to be a *de facto* acquiescence to the validity of the Examiner's rejection under 35 USC 112, first paragraph, regarding the inadequate disclosure of the spring-loaded

retaining plate/member in the parent application SN'561 and grand parent application SN'022. Furthermore, Appellant's filing of the instant CIP application is considered as a *de facto* admission that this application contains new matter to overcome the mentioned rejection under 35 USC 112, first paragraph.

In summary, the instant application is not entitled to the filing date of SN'022 since SN'022 fails to comply with the adequate disclosure requirement under 35 USC 112, first paragraph. *In re Huston, supra*. Consequently, Gapinski is a valid reference under 35 USC 102(e) because Gapinski was filed before the filing date of the instant CIP application.

The Examiner has ordered the files of the parent application SN'561 and the grandparent application SN'022. If the Board needs these files for finding of facts set forth above, please call the Examiner at telephone number 703-308-3221, the Examiner will promptly submit these files to the Board.

II. Whether claims 5-8 are anticipated under 35 USC 102(e) by Gapinski?

At the outset, Appellant states that Appellant points out very clearly why the present invention is not obvious and not disclosed by Gapinski in the heading II on page 21 and page 25 of the brief. The Examiner respectfully submits that the rejection is based on anticipation, not obviousness. Therefore, Appellant's arguments regarding the issue of obviousness are apparently misplaced.

The thrust of Appellant's arguments is that Gapinski's mode of operation/use is different from Appellant's mode of operation/use. See page 22 of the brief. Appellant asserts that Gapinski's cleat adapter 22 can be removed from the road style clipless structure 26 by twisting the rear edge 46 of the cleat outwardly (away from the crank arm to which the pedal is attached)

in the lateral plane (of the top surface of the main body of the pedal) with respect to the pedal 20, meanwhile, Appellant's cleat is received and locked in place by the spring action from the rear portion of the flip-flop pedal of the present invention. Appellant apparently overlooks the spring 112 shown in Fig. 8 of Gapinski and described, e.g., in col. 5, line 55 to col. 6, line 22. Gapinski's cleat 22 is plainly received and locked in place by the spring action of the spring 112 from the rear portion of Gapinski's flip-flop pedal 20 in the same manner as the present invention. Therefore, Appellant's claims are anticipated by Gapinski. On the other hand, Appellant's functional statement regarding the intended use or mode of operation is not accorded patentable weight in the Appellant's apparatus claims. See *In re Casey*, *In re Otto*, *In re Schreiber*, and *Ex parte Masham* cited in Paper No. 6.

CONCLUSION

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Vinh T. Luong
Primary Examiner

Conferees on February 26, 2004

SPE David Bucci and

SPE Jack Lavinder

